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EXAMINER	
CLARK, J	
ART UNIT	PAPER NUMBER
3764	17

DATE MAILED:

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Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No.
08/753,929

Applicant(s)
Rothschild et al.

Examiner
Jeanne Clark

Group Art Unit
3764



☒ Responsive to communication(s) filed on Jan 22, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-15, 17-27, 36, and 37 is/are pending in the application.

Of the above, claim(s) 6-8, 11, 12, 19-23, 25, 26, 36, and 37 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 13, 15, and 27 is/are rejected.

☒ Claim(s) 2-5, 9, 10, 14, 17, 18, and 24 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3302

DETAILED ACTION

Claims 6-8,11,12,19-23,25,26,36 and 37 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected species, the requirement having been traversed in Paper No. 5.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,13,15, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Mason et al [4938777] in view of Whiteside [5022390].

In regard to claim 1, Mason teaches a method of forming a foot orthosis comprising bonding (i.e. molding) a thermoformable plastic material 10 at a predetermine location to a thermoformable plastic sheet 18 (column 4 lines 31-41). Mason discloses the claimed invention except for the specific steps of forming the positive mold and vacuum sealing as claimed.

Whiteside teaches it is well know in the art to form a positive mold of the lower extremity, wrapping a multiple of thermoformable plastic material about the mold and vacuum sealing the materials and the mold so that the materials are "bond" together (column 2 lines 35-49). It would

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have been obvious to one of ordinary skill in the art at the time the invention was made to form the foot orthosis using the method steps as taught by Whiteside in order to create an strong and semi-flexible orthosis economically.

In regard to claim 13, Whiteside teaches the steps of cooling and trimming as claimed in the formation of the orthosis. **In regard to claim 15**, Mason discloses a foot orthosis comprising a rigid support structure formed from a thermoplastic material [10] wherein the support is reinforced in predetermined areas with additional thermoplastic material [18]. Whiteside teaches the bonding on different thermoformable materials together. See the rejection of claim 1. **In regard to claim 27**, the mold is considered to be "modified" as broadly as claimed.

Allowable Subject Matter

Claims 2, 3, 4, 5, 9,10,14,17,18 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to claims 1,13,15 and 27 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

The applicant should note that nonelected claims 36 and 37 are still pending in the application. However, these claim depend on canceled claim 28.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeanne Clark whose telephone number is (703) 308-0063. Beginning April 1, 1999 all correspondence may be addressed to Art Unit 3764.

J Clark
April 8, 1999


JEANNE M. CLARK
PRIMARY EXAMINER